

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONEY J. MATIJECA

Appeal No. 2001-0826
Application No. 09/064,486

ON BRIEF

Before KIMLIN, WARREN, and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 through 24, which are all the claims pending in this application.

THE INVENTION

The invention is directed to a method of forming a rigid polyurethane foam. The method comprises contacting a polyisocyanate and a low molecular weight compound having two to three active hydrogen groups in the presence of water. The foam is formed

in the absence of a polyol having a hydroxyl functionality greater than three. Additional limitations are provided in the following illustrative claim.

THE CLAIM

Claim 1 is illustrative of appellants' invention and is reproduced below:

1. A method for forming a polyurethane foam comprising: contacting a first reactant comprised of a polyisocyanate having an average isocyanate functionality of at least 2 and a second reactant comprised of a low molecular weight compound that has at least two to, at most, three groups containing an active hydrogen in the presence of water for a time sufficient to form a substantially rigid foam, provided the foam is formed essentially in the absence of a cross-linking polyol having a hydroxyl functionality greater than 3.

THE REFERENCE OF RECORD

As evidence of anticipation, the examiner relies upon the following reference:

Gott et al. (Gott)	5,234,965	Aug. 10, 1993
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THE REJECTION

Claims 1 through 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gott.

OPINION

We have carefully considered all of the arguments advanced by the appellant and the examiner, and agree with the appellant for the reasons set forth in the Brief and those herein that the rejection of record is not well founded. Accordingly, we reverse the rejection.

THE REJECTION UNDER SECTION 102(b)

In order for a claimed invention to be anticipated under 35 U.S.C. § 102(b), all of the elements of the claim must be found in one reference. See Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

It is the examiner's position that "anticipation is held evident for all claims 1-24." See Answer, page 4. We disagree.

We find that Gott is directed to a process for the preparation of a flexible, semi-flexible or rigid polyurethane foam. See column 1, lines 6-8. The foam is prepared by reacting an organic polyisocyanate, a polyhydric compound and a blowing agent among other components. See column 2, lines 5-14. We find that isocyanate compounds within the scope of the claimed matter are disclosed at column 2, line 29 to column 3, line 5. We find that the polyhydric component is disclosed at column 3, line 6 to column 4, line 58. The component includes compounds having a molecular weight of from 200 to 3,000 and has a functionality of 2 to 8 hydroxyl groups. See column 3, lines 6-15. We find that suitable polyhydric compounds are disclosed at column 4, lines 39-58. They are however, disclosed only with respect to hydroxyl number and we cannot ascertain either their molecular weight or their functionality. Accordingly, we cannot conclude that they fall within the scope of the claimed subject matter as being a low molecular compound.

Based upon the above findings, we conclude that in order to arrive at the claimed

subject matter, a person having ordinary skill in the art would have to carefully pick and choose and combine various disclosures among the teachings of Gott to obtain the requisite component to prepare the rigid polyurethane foam required by the claimed subject matter. While picking and choosing may be entirely proper in making an obviousness rejection under 35 U.S.C. § 103, it has no place in making a rejection under 35 U.S.C. § 102(b) for anticipation. See In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972). Furthermore, we conclude that Gott does not provide a disclosure with sufficient specificity to constitute a description of the claimed composition within the purview of 35 U.S.C. § 102(b). See In re Schaumann, 572 F.2d 312, 315, 197 USPQ 5, 8 (CCPA 1978). Accordingly, we do not sustain the rejection of the claims on appeal under 35 U.S.C. § 102(b) as anticipated by Gott.

OTHER MATTERS

Upon return of this case to the jurisdiction of the examiner, careful consideration should be given to instituting a rejection of each of the claims under Section 103(a) over Gott.

Gott discloses the preparation of a rigid urethane foam composition utilizing a polyol having a molecular weight of 200. See column 3, line 7. The specification defines the molecular weight of the low molecular weight compound (LMWC) as being at most about 200. See specification, page 8. It is well established that a, "claimed invention is rendered prima facie obvious by the teachings of a prior art reference that discloses a range

that touches the range recited in the claim.” See In re Geisler, 116 F.3d 1465, 1469-70, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997). Gott further discloses the requisite polyisocyanate, column 2, line 29 - column 3, line 5. Water is disclosed as a blowing agent at column 6, lines 62-64. Furthermore, the method of the claimed subject matter requiring contacting the two components in the presence of water is disclosed in the form of a one shot process wherein all the necessary ingredients are mixed together. See column 8, lines 22-26. Accordingly, the requisite elements, components and method steps required to establish a prima facie case of obviousness with respect to at least claim 1 are disclosed by Gott.

DECISION

The rejection of claims 1 through 24 under 35 U.S.C. § 102(b) as being anticipated by Gott is reversed.

The decision of the examiner is reversed.

REVERSED

EDWARD C. KIMLIN
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

PAUL LIEBERMAN
Administrative Patent Judge

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